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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,332	06/18/2001	Jean-Claude Fournier	T214-907321	8912
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MILES & STOCKBRIDGE PC			ANWAH, OLISA	
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MCLEAN, VA 22102-3833			2645	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/868,332	Applicant(s) FOURNIER ET AL.	
	Examiner Olisa Anwah	Art Unit 2645	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 25-44 and 46-48 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 25-31, 34-38, 41-44 and 46-48 are rejected under 35 U.S.C. § 102(e) as being anticipated by Donovan et al, U.S. Patent No. 6,519,468 (hereinafter Donovan).

Regarding claim 25, Donovan discloses a message transmission system comprising a telecommunication network (150) comprising a communication server and at least one wireless telephone (182), the server (see Figure 2) comprising means for sending messages to one or more wireless telephones, the wireless telephone or telephones being equipped with means for storing and processing messages, wherein each message comprises

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a first field (722) containing at least one information in a plurality of sub-fields relating to the standard profile of the recipient of the message, and in that the processing means identifies and compares each information of the standard profile contained in the message with each matching information in the profile stored in each wireless telephone relative to the subscriber using the wireless telephone and authorizes the storage of the message in the storage means if the profile of the subscriber using the wireless telephone is compatible with the standard profile contained in the first field of the message (see Figure 5).

Regarding claim 26, see column 8.

Regarding claim 27, see column 3.

Regarding claim 28, see column 3.

Regarding claim 29, see column 8.

Regarding claim 30, see column 8.

Regarding claim 31, see column 8.

Regarding claim 34, see column 8.

Regarding claim 35, see column 8.

Regarding claim 36, see column 8.

Regarding claim 37, see column 7.

Regarding claim 38, see column 7.

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Regarding claim 41, Donovan discloses a method for transmitting messages in a telecommunication network (150) comprising a communication server and at least one wireless telephone (182), said server (see Figure 2) comprising means for sending messages to one or more wireless telephones, the wireless telephone or telephones being equipped with means for storing and processing messages, wherein it comprises:

- a step for sending a message comprising a field (722) containing at least one information in a plurality of sub-fields relative to the standard profile of the recipient of the message, and

- a step for processing the message received by the recipient, for identifying and for comparing each information of the sub-fields in the standard profile contained in this message with each information of a user's subscriber profile stored in the memory of the wireless telephone,

- a step for storing the message in the storage means of the wireless telephone if the user's subscriber profile is compatible with the standard profile contained in the message (see Figure 5).

Regarding claim 42, see Figure 5.

Regarding claim 43, see column 8.

Regarding claim 44, see column 8.

Regarding claim 46, see column 8.

Regarding claim 47, Donovan discloses a method for utilizing services offered by a service provider via a message transmission system comprising a telecommunication network (150) including a communication server (see Figure 2) and at least one wireless telephone (182) comprising sending a message to said at least one wireless telephone, storing the message in the wireless telephone, processing the message in the wireless telephone, each message comprising a first field (722) containing information relating to the type profile of the recipient of the message, comparing the profile stored in the wireless telephone relative to the subscriber using the wireless telephone with the profile contained in the message and authorizing the storage of the message in a memory in the wireless telephone if the profile of the subscriber using the wireless telephone is compatible with the type profile contained in the first field of the message (see Figure 5).

Regarding claim 48, see column 8.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 32, 33, 39 and 40 are rejected under 35 U.S.C § 103(a) as being unpatentable over Donovan in view of Alperovich et al, U.S. Patent No. 6,119,014 (hereinafter Alperovich).

Regarding claim 32, Donovan does not show the claimed counter. However Alperovich teaches this limitation (see column 4). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Donovan with the message of Alperovich. This modification would have improved the convenience of Donovan by allowing an SMS message to be displayed at predefined intervals as suggested by Alperovich.

Claim 33 is rejected for the same reasons as claim 32.

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Regarding claim 39, Donovan inherently teaches the claimed searching limitation (see Figure 5) but Donovan fails to show the claimed erasing limitation. However Alperovich teaches this limitation (see column 4). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Donovan with the message of Alperovich. This modification would have improved the convenience of Donovan by allowing an SMS message to be displayed at predefined intervals as suggested by Alperovich.

Regarding claim 40, Donovan does not show the claimed notifications. However Alperovich teaches this limitation (see column 4). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Donovan with the message of Alperovich. This modification would have improved the convenience of Donovan by allowing an SMS message to be displayed at predefined intervals as suggested by Alperovich.

***Allowable Subject Matter***

5. Claim 45 is allowed because the Prior Art of record does not teach the claimed sending step.



***Response to Arguments***

6. Applicant alleges that Donovan does not show the claimed information in a plurality of sub-fields. The Examiner respectfully disagrees. The short message type field (722) of Donovan is functionally equivalent to Applicant's claimed first field. Donovan states that the short message type field (722) is assigned one octet (see line 44 from column 7). Because an octet is an eight-bit byte, the information contained in each bit of the eight-bit byte reads on the claimed information in a plurality of sub-fields. Hence at step 506 of Donovan, each bit of the eight-bit byte (722) is compared with matching information in the profile. For this reason, the Examiner cannot allow the claims as presently claimed.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

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of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

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O.A.

Olisa Anwah

Patent Examiner

February 28, 2006

  
**FAN TSANG**  
**SUPERVISORY PATENT EXAMINER**  
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